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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,821	01/17/2002	Hiroki Takaoka	725.1152	5336

21171 7590 12/14/2004
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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,821	Takaoka et al.	
	Examiner	Art Unit	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 14, 2004 and September 3, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 8-14, 22, 23, and 25 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-14, 22, 23, and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 17, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>- 3 -, 20040714, and 20040903.</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the arguments filed by applicant on July 14, 2004, and to the amendment and arguments filed by applicant on September 3, 2004, both in reply to the previous Office action, mailed June 3, 2004.

2. The amendment of claims 1, 2, 8-14, 22, 23, and 25, and the cancellation of claims 3-7, 15-21, and 24, by applicant on September 3, 2004 are hereby acknowledged.

Response to Amendment

3. The amendment filed September 3, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (1) that the "second price providing means" transmits "the automobile of desired specifications," as opposed to just the specifications for the desired automobile (amended claims 1, 23, and 25); and, (2) that a dealer cannot browse another dealer's estimated prices stored in the other dealer's at least one second database, or, in other words, that the data therein is not publicly viewable by anybody (amended claim 11).

Applicant is required to cancel the new matter in the reply to this Office action.

Therefore, for purposes of further consideration of the claims, hereinbelow, the claims will be

(1) construed as reciting the transmission of specifications for automobiles, not the automobiles themselves; and, (2) construed as reciting that a dealer is unable to update/change the prices of another dealer, as opposed to being unable to merely view the data, since the data is publicly available and viewable to any potential buyer (i.e., including the buyer being another dealer).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 8, 10-14, 22, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolfe et al. (US 6,282,517).

Wolfe et al. disclose an estimated price providing method and apparatus for an automobile comprising: a first database in which an automobile manufacturer's suggested retail prices are registered in advance for respective predetermined automobile specifications that the automobile manufacturer can supply; at least one second database that includes an automobile dealer's estimated prices that are registered in advance for the respective predetermined automobile specifications; customize means for allowing a user of an information terminal connected to said estimated price providing apparatus via a communication line to select an automobile of desired specifications in accordance with the respective predetermined automobile specifications by operations from the information terminal; first price providing means for referring to said first database and transmitting the manufacturer's suggested retail price for an automobile of desired specifications selected by said customize means to the information terminal; dealer select means for allowing the user to select the automobile dealer by operations from the information terminal; and, second price providing means for transmitting an estimated price of the automobile dealer selected by said dealer select means and transmitting the automobile of desired specifications selected by said customize means to the information terminal in a name for the automobile dealer selected by said dealer select means.

Regarding claims 2 and 22, the method and apparatus of Wolfe et al. comprises the second price providing means providing the estimated price via e-mail using an e-mail message

in which an e-mail address that specifies the automobile dealer selected by the user is set as a source of the automobile of desired specifications, it being inherent that the e-mail from the dealer selected by the user being sent to the user would specify who it was from.

Regarding claim 8, the apparatus of Wolfe et al. further comprises means for providing all estimated prices of the automobile of desired specifications, which were previously provided to the user, to be able to be displayed as a list on the information terminal in response to a query request by the user at the information terminal, it being inherent that the e-mail messages from the various dealers respectively containing each dealer's estimated prices of the automobile of desired specifications would be able to be stored and displayed as a list in the e-mail inbox and/or the e-mail server of the user.

Regarding claims 10-12, the apparatus of Wolfe et al. further comprises an estimated price updated means for permitting to browse and/or update the automobile dealer's estimated prices of said at least one second database in response to a request from the automobile dealer corresponding to said at least one second database, and denying update access of said at least one second database by either the automobile manufacturer or by another automobile dealer that does not correspond to said at least one second database.

Regarding claims 13 and 14, the customize means of the apparatus of Wolfe et al. executes a selection of drive system components that form a backbone of the automobile which can be manufactured by the automobile manufacturer, and then said customize means executes a selection of additional peripheral components appropriate/compatible with the components

previously selected, the components being registered in advance in correspondence with the selected drive system components, but, in any event, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight in distinguishing the claimed invention over the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Regarding claims 23 and 25, the estimated price providing apparatus of Wolfe et al. comprises a computer program instructing a computer to operate as an estimated price providing apparatus, and the program code of the computer program that makes the computer operate as the estimated price providing apparatus is stored on a computer-readable medium.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al. (US 6,282,517).

Wolfe et al. disclose an estimated price providing apparatus for an automobile, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but Wolfe et al. fail to specifically disclose means for transferring an estimation request of a trade-in automobile to the automobile dealer selected by said dealer select function when the estimation request of the trade-in automobile is received from the user of the information terminal.

However, requesting a trade-in value estimate from a dealer from whom a buyer is considering buying a new car is certainly a well known, hence obvious, step to follow in the process of purchasing a new car, when one currently has a current car that they wish to replace with the new car.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the estimated price providing apparatus of Wolfe et al. so as to enable a user purchasing a new car by means of the apparatus to submit to the selected dealer a request for an estimation of a trade-in value of a trade-in automobile, as is well known to do in the conventional process of purchasing a car, in order to allow the user to best gauge the true net cost of purchasing the new car, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

8. Applicant's arguments filed July 14, 2004 and September 3, 2004 have been fully considered but they are not persuasive.

9. The arguments of July 14, 2004, regarding the formality defects of the previous Office action (by the previous examiner) have been considered, but have been obviated and rendered moot by applicant's timely and substantive response of September 3, 2004 to the previous Office action, mailed June 3, 2004. See MPEP § 710.06.

10. The arguments of September 3, 2004 regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. PLEASE TAKE NOTICE that the examiner handling this application has changed. The new examiner is *Jerry O'Connor*. The Group Art Unit number is unchanged and is still 3627.

13. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

December 10, 2004

A handwritten signature in black ink, appearing to read 'Gerald J. O'Connor', followed by the date '(12-10-04)' in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627